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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,917

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Teruaki Itoh

160-402 (AMK)

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01/28/2008

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

WRIGHT, PATRICIA KATHRYN

ART UNIT

PAPER NUMBER

1797

MAIL DATE

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01/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/730,917	Applicant(s) ITO, TERUAKI	
	Examiner P. Kathryn Wright	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 07, 2008 has been entered.

Status of the Claims

2. This action is in response to papers filed January 07, 2008 in which claim(s) 1, 4, 7 and 9 were amended and claim(s) 3, 6 and 8 were cancelled. The amendments have been thoroughly reviewed and entered.

Claims 1, 4, 7 and 9 are under prosecution.

Any objection/rejection not repeated herein has been withdrawn by the Office.

Information Disclosure Statement

3. The information disclosure statement filed June 04, 2007 does comply with 37 CFR 1.98(a)(3) and information referred to therein has been considered.

In the REMARKS/ARGUMENTS section of the Reply filed January 07, 2008, Applicant states that each of the listed Japanese references were cited in a counterpart foreign application and the requirement of a concise explanation of the relevance can

be satisfied by submitting an English-language version of the Search Report. This has been found persuasive and the Examiner has considered these references.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 4, 7 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 now recites "a cylindrical body having a constant diameter". The Examiner cannot locate any support in the specification for the recitation that the cylindrical body (of the insertion section) has a constant diameter. Furthermore, one cannot determine that the diameter of the cylindrical body is in fact constant since drawings cannot be relied upon for scale. Therefore, claim 1 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 4, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over C. J. Jesnig (US Patent No. 2,848,130) in view of Tatsumi et al., (US Patent No. 4,915,243), hereinafter "Tatsumi", or Rumpler (US Patent No. 4,193,402).

Jesnig teaches a stopper for a tubular container 10. The stopper comprises an inserting section 37, a closing section 27 having a flat surface 16 (Fig. 3) that is configured to close an opening of the container when brought into intimate contact with a rim of the container opening (see Figs. 20, 21). The Jesnig stopper also includes an "operating section" 44. An annular groove 45 is provided between the operating section and the closing section 27. Note that nothing in the claim structurally differentiates the operating section from the surface 44 of Jesnig. Thus, the surface 44 of the cap reads on the claimed "operating section".

The inserting section of the Jesnig stopper is formed of an elastically deformable liquid-tight member (see col. 6, lines 38+). The inserting section also includes a cylindrical body 33 having constant diameter (see element 33 in Fig. 6) and a tapered annular flange 34 projected from the cylindrical body such that the tapered annular flange presses against the inner surface of the tube-shaped specimen container to seal the container in fluid-tight manner. The annular flange section includes a plurality of

notches 40 or channels 60 which allow the flange to readily collapse the diameter of the insertion section to assist in the placing the insertion section of the stopper into the container, see col. 6, lines 38-45.

Note that the claims are drawn to the stopper, not the combination of container and stopper. The container is not positively recited in the claim, and therefore considered an intended use. The recitation with respect to the manner in which a claimed apparatus is intended to be employed, (i.e., liquid-tightly pressed on an inner surface of the container) fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (i.e., structural limitation of the stopper). *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

As discussed above, Jesnig does teach a tapered annular flange to frictionally engage the inner surface of the container; however, Jesnig does not specifically teach the use of at least two tapered annular flanges. However, the use of a plurality of annular flanges is known in the art, see for example Tatsumi or Rumpler.

Tatsumi teaches a stopper for a tubular container B. The stopper comprises an inserting section 3, a closing section 3' and an operating section 1 (see Fig. 10). The inserting section is configured to be fitted into a container. The inserting section is formed of an elastically deformable liquid-tight member (i.e., rubber; see col. 5, line 57 et seq.) The inserting section also includes a cylindrical body having a constant diameter and at least two tapered annular flanges 4 and 7 projected from the cylindrical body such that the tapered annular flange presses against the inner surface of the tube-

shaped specimen container to seal the container in fluid-tight manner (see Fig. 9).

Tatsumi teaches it would be desirable to include another flange 7 in order to prevent lateral movement or rolling phenomenon that often occurs when only one flange is used to press on the inner surface of the container (see col. 6, line 53 et seq.) Furthermore, the court has held that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Rumpler teaches a stopper for a tubular container 15. The stopper comprises an inserting section 2 and a closing section 1 integrally connected to the inserting section. The closing section is configured to close an opening of the container when brought into intimate contact with a rim of the opening (see Fig. 5). The inserting section is formed of an elastically deformable liquid-tight member (see col. 4, lines 15+). The inserting section also includes a cylindrical body having a plurality of tapered annular flanges 5, 6 projected from the cylindrical body such that the tapered annular flange presses against the inner surface of the tube-shaped specimen container to seal the container. The annular flange section includes a plurality of notches 7 which allow the flange to readily collapse the diameter of the insertion section to assist in the placing the insertion section of the stopper into the container, see Fig. 5.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have included a plurality of tapered flanges of Tatsumi or Rumpler, on the stopper system of Jesnig, since Tatsumi teaches it would be desirable to use another flange in order to prevent lateral movement or rolling

phenomenon that often occurs when only one flange is used to press on the inner surface of the container (see col. 6, line 53 et seq.) Furthermore, the court has held that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over C. J. Jesnig (US Patent No. 2,848,130) in view of Tatsumi (US Patent No. 4,915,243), or Rumpler (US Patent No. 4,193,402), as applied to claim 1 above, and in further view of Gerarde (US Patent No. 3,902,477).

The teachings of Jesnig, Tatsumi and Rumpler have been previously summarized, *supra*. The combined system of Jesnig Tatsumi and Rumpler does not explicitly teach the insertion section and closing section being formed of polypropylene resin (claim 7).

Gerarde teaches a stopper 30 including, *inter alia*, an inserting section and a closing section 29. The inserting section has a cylindrical body 28 for insertion into a container 10, see for example Fig. 1. The container and stopper of Gerarde are made of an inert material, in particular, polypropylene resin since it does not react with or in any way adversely affect the specimen to be stored therein (see col. 2, line 3+).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have made the container and stopper system Jesnig, Tatsumi and Rumpler from polypropylene resin, as taught by Gerarde, since

polypropylene does not react with or in any way adversely affect the specimen to be stored therein (see col. 2, line 3+).

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to determine the optimum materials of construction based on considerations such as cost, ease of manufacture, reactions with the processing agents and/or maintaining the required reaction conditions with respect to temperature.

Response to Arguments

9. Applicant's arguments filed January 07, 2008 have been fully considered but they are not persuasive. With respect to the previous rejection of claims 1-3 under 35 U.S.C. 102(b) as being anticipated by C. J. Jesnig (US Patent No. 2,848,130), Applicant argues that stopper of Jesnig does not include an annular groove provided between the operating section and closing section. Furthermore, Applicant alleges that Jesnig does not teach the inserting section with a cylindrical body having a constant diameter and two annular flanges.

The Examiner respectfully disagrees with Applicant's assertions. Giving the claims the broadest reasonable interpretation, the Jesnig stopper does include an "operating section" 44 with annular groove 45 being provided between the operating section and the closing section 27, see Figs. 1-11. Nothing in the claim structurally differentiates the operating section from the surface 44 of Jesnig. Thus, the surface 44 of the cap reads on the claimed "operating section". Please note, that although the claims are interpreted in light of the specification, limitations from the specification are

not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, contrary to Applicant's assertion, the inserting section of Jesnig has a cylindrical body having a constant diameter (see cylindrical area 33 located between 30 and 34 in Fig. 6). With respect to the assertion that Jesnig does not teach two annular flanges, the Examiner relies on Tatsumi (US Patent No. 4,915,243), or Rumpler (US Patent No. 4,193,402) for the teaching of a stopper system having at least two annular flanges, as discussed above.

Conclusion

10. No claims allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

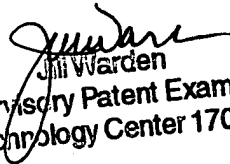
Status information for unpublished applications is available through Private PAIR only.

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pkw


Jill Varden
Supervisory Patent Examiner
Technology Center 1700